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NXP, B.V. NXP INTELLECTUAL PROPERTY & LICENSING M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			DESIR, PIERRE LOUIS	
			ART UNIT	PAPER NUMBER
			2617	
			NOTIFICATION DATE	DELIVERY MODE
			08/06/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

### Office Action Summary

**Application No.**

10/023,118

**Applicant(s)**

MEINDL ET AL.

**Examiner**

PIERRE-LOUIS DESIR

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 05/24/2010 have been fully considered but they are not persuasive.

On page 7 of the remarks, applicants argue that Novis does not teach "having second communication means disposed within the housing for the contactless retrieval of control information stored in a data carrier, wherein the data carrier is a SIM card, wherein the data carrier is disposed completely outside of the housing of the processing device and is adhesively attached to the housing of the processing device and wherein the data carrier is configured to communicate wirelessly with the second communication means through a wall of the housing of the processing device.

Examiner respectfully disagrees.

As previously disclosed, Novis discloses in col. 3, lines 41-45 that it will of course be understood that while slot 16 is preferable for correctly positioning smart card 18, other structures might be utilized, including simply placing smart card 18 adjacent to a sensor structure that is **externally** accessible.

One skilled in the art would find it obvious that having a sensor structure being externally accessible, the smart card, which can be a contactless smart card, would not need to be in direct contact with the sensor. One skilled in the art would find it obvious in that context that the smart card is located outside of the housing, and while external to the processing device, the smart card communicates with communication means of the processing device through the sensor structure (i.e., communicates wirelessly through a wall of the housing of the processing device).

Furthermore, throughout applicants' arguments, there is not mention of Novis disclosing that the smart card may be a contactless smart card, and in that case, the smart card may include infrared sensors, RF sensors. What, it appears that applicants are arguing that even in a non-contact smart card, the smart card would still need to be inserted in the slot to be in contact with the sensor structure. Such argument would be moot because it would defeat the concept of contactless smart card, which only requires interface for contactless operation not for direct operation. Therefore, Novis' disclosure that the sensor structure could be accessed externally does apply or at the very least does provide concrete proof that the contactless smart discloses by Novis can be in communication with the sensor structure using the contactless/wireless/non-contact interface.

Applicants further argue that Novis does not disclose that the smart card is a SIM card. It is well known in the art that Smart cards are SIM card. A new reference is being to introduce to further prove such knowledge.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 9, 10, 16-17, 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novis in view of Sakashita, further in view of Blanke (US 20010046850 A1)

Regarding claim 1, Novis discloses a processing device for the processing of an information signal (i.e., portable electronic device) (see fig. 1), the device having a housing (i.e., housing 11) (see figs. 1-2) and having, first communication means disposed within the housing for receiving and/or transmitting the information signal (i.e., two-way voice communication transceiver 24) (see fig. 3, col. 3, lines 59-61), and having processing means for the processing of the information signal received and/or transmitting (i.e., CPU) (see col. 4, line 4), and having a second communication means disposed within the housing for the contactless retrieval of control information stored in a data carrier, wherein the data carrier is disposed completely outside of the housing of the processing device (i.e., sensor structure 19, which can include electronic sensors for the contactless retrieval of information) (see fig. 3, col. 3, lines 38-41; col. 4, lines 22-27; and col. 11, lines 29-30), wherein the data carrier is configured to communicate wirelessly with the second communication means through a wall of the housing of the processing device (i.e., it will of course be understood that while slot 16 is preferable for correctly positioning smart card 18, other structures might be utilized, including simply placing smart card 18 adjacent to a sensor structure that is externally accessible. Thus, the smart card can be placed completely outside of the housing of the processing device. Therefore, one skilled in the art would appreciate that the smart card, while external to the processing device, communicates with communication means of the processing device through the sensor structure (i.e., communicates wirelessly through a wall of the housing of the processing device) (col. 3, lines 41-45), in which the processing of the information signal by the processing means can be influenced with the aid of the retrieved control information (see col. 4, lines 27-33).

Novis, however, does not specifically disclose that the smart card is adhesively attached to the housing of the processing device.

Sakashita discloses a non-contact type data carrier label that has a data carrier for storing information and a support member for holding the data carrier, and it is able to attach to a product. A releasable type adhesive layer is formed on the support member, which allows the data carrier label to be attached to and detached from a product (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings disclosed by Sakashita with the teachings described by Novis to arrive at the claimed invention. A motivation for doing so would have been to easily attach and detach the label.

The combination, however, does not specifically disclose that the smart card is a SIM card.

However, Blanke discloses a smart card that is a SIM card (see paragraph 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings as described to arrive at the claimed invention. A motivation for doing so would have been to properly identify the subscriber related to the terminal.

Regarding claim 2, the combination of Novis with Sakashita discloses a processing device (see claim 1 rejection) in which the detachable connection of the data carrier to the housing of the processing device is formed by an adhesive joint (i.e., A releasable type adhesive layer is formed on the support member, which allows the data carrier label to be attached to and detached from a product (see abstract). Also refer to claim 1 for reason to combine.

Regarding claim 4, Novis discloses a processing device (see claim 1 rejection), in which the housing of the processing device has a recess, in which recess the data carrier can be connected detachably to the housing (i.e., slot) (see col. 3, lines 36-38).

Regarding claims 9-10, Novis discloses a data carrier (smart card) (see fig. 1), which includes a third communication means for the communication with the second communication means of the processing device (i.e., smart card circuitry) (see col. 4, lines 10-12) and a memory means for storing control information, which can be processed by a processing device (i.e., the CPU is programmed to interface with the memory and circuitry on smart card) (see col. 4, lines 10-12). Novis also discloses a smart card interface is used to couple the smart card to the CPU. The card interface may include electronic sensors in the case of contactless cards (as related to claim 10, it is well known in the art, Contactless-type smart cards is governed by the ISO 14443 standard) (see col. 11, lines 26-30).

Although, Novis discloses a data carrier as described, Novis does not specifically disclose a data carrier embedded in an adhesive label which adhesive label can be connected detachably to a processing device.

Sakashita discloses a non-contact type data carrier label that has a data carrier for storing information and a support member for holding the data carrier, and it is able to attach to a product. A releasable type adhesive layer is formed on the support member, which allows the data carrier label to be attached to and detached from a product (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings disclosed by Sakashita with the teachings described by

Novis to arrive at the claimed invention. A motivation for doing so would have been to easily attach and detach the label.

The combination, however, does not specifically disclose that the smart card is a SIM card.

However, Blanke discloses a smart card that is a SIM card (see paragraph 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings as described to arrive at the claimed invention. A motivation for doing so would have been to properly identify the subscriber related to the terminal.

Regarding claims 16 and 17, Novis discloses a processing device (see claim 1 rejection) wherein the housing of the processing device does not have an opening (i.e., as disclosed in the rejection of claim 1, Novis discloses that it will be understood that while slot 16 is preferable for correctly positioning smart card 18, other structures might be utilized, including simply placing smart card 18 adjacent to a sensor structure that is externally accessible (col. 3, lines 41-45). Thus, one skilled in the housing of the processing device would not include the slot (i.e., the processing device does not have an opening). And as related to claim 17, since the slot would not be included in the case of a contactless card, the housing of the processing does not have a cover because no housing cover is needed to protect the contactless phone)

Regarding claim 19, the combination of Novis and Sakashita discloses a processing device (see claim 16 rejection) wherein the data carrier is embedded in an adhesive label, and



wherein the adhesive label is attached to the housing of the processing device at a location on the housing that provides optimum protect against damage to the data carrier (as disclosed in claim 1 rejection, Sakashita discloses a non-contact type data carrier label that has a data carrier for storing information and a support member for holding the data carrier, and it is able to attach to a product. A releasable type adhesive layer is formed on the support member, which allows the data carrier label to be attached to and detached from a product (see abstract). And, it is well known in the art to have a card recess on the back of the device. Therefore, by having Sakashita disclosing the use of releasable type adhesive layer to attach a data carrier to a product, one skilled in the art would find it obvious to attach the non-contact data carrier on the back of the housing or any other place the user feels appropriate).

Regarding claim 20, the combination of Novis with Sakashita discloses a processing device (see claim 19 rejection) wherein the adhesive label is attached to a rear wall of the housing of the processing device (Please refer to claim 19 reasoning)..

Regarding claim 21, the combination of Novis with Sakashita discloses a processing device (see claim 20 rejection) wherein the rear wall has a recess, wherein the adhesive label is attached to the rear wall in the recess such that a surface of the adhesive label does not extend over the rear wall beyond the recess (i.e., the data carrier label that is configured for attachment to a structure comprises a support member having a top surface and a bottom surface each extending to a perimeter edge, the bottom surface including a recess and a pasting surface extending formed the **recess** to the perimeter edge; an electronically readable/writable non-contact type data carrier, the data carrier being disposed within the recess on the bottom surface of the support member; and a releasable type adhesive positioned on at least a portion of the

pasting surface of the support member such that the bottom surface of the support member can be removably secured to the structure (see claim 15 of the reference). Thus, one skilled in the art would find it obvious when attached on the product, the product not contains a recess within which the data carrier is included).

Regarding claim 22, the combination of Novis with Sakashita discloses a processing device (see claim 21 rejection) wherein the data carrier is attached directly opposite the second communication means with respect to the rear wall of the housing (as disclosed in claim 1 rejection, Sakashita discloses a non-contact type data carrier label that has a data carrier for storing information and a support member for holding the data carrier, and it is able to attach to a product. A releasable type adhesive layer is formed on the support member, which allows the data carrier label to be attached to and detached from a product (see abstract). And, it is well known in the art to have a card recess on the back of the device. Therefore, by having Sakashita disclosing the use of releasable type adhesive layer to attach a data carrier to a product, one skilled in the art would find it obvious to attach the non-contact data carrier on the back of the housing or any other place the user feels appropriate)..

Regarding claim 23, Novis discloses a processing device (see claim 22 rejection) wherein the processing device is a DVD player, a CD player or a computer (i.e., a portable electronic device) (see abstract).

5. Claim 3 is rejected under 35 U.S.C 103(a) as being unpatentable over Novis and Sakashita, further in view of Amtmann et al. (Amtmann) (cited by applicant).

The combination of Novis with Sakashita discloses a processing device as described above (see claim 1 rejection).

Although the combination discloses a processing device as described, the combination does not specifically disclose a processing device where the second communication means are adapted to generate high frequency signal, which can be utilized by the data carrier to produce supply voltage.

However, Amtmann discloses a processing device where its transmission and receiving characteristics are arranged so they can produce modulated carrier signal (high frequency signal), and such modulated carrier signal generated by the processing device can be used by the smart card (data card) to generate an operating voltage and to communicate with the control information (see figure 1 and 10, and page 7, lines 5-24).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the references to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper communication function of the data carrier.

6. Claims 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novis and Sakashita, further in view of Page et al. (Page), U.S. Patent No. 6801787.

Novis discloses a processing device (see claim 1 rejection), in which the processing device takes the form of a mobile telephone (i.e., conventional cellular telephone) (see col. 3, lines 56) whose first communication means are adapted to receive and to transmit a telephone

signal (i.e., two-way voice cellular transceiver) (see col. 2, lines 49-51) and whose processing means are adapted to process the telephone signal received and to be transmitted (see fig. 4, col. 4, lines 27-33).

Although the combination discloses a device as described, the combination does not specifically disclose a device wherein the control information retrieved from the detachably connected data carrier by the second communication means identifies a telephone number of the user of the mobile telephone and/or includes calling credit information.

However, Page discloses a portable smart card communication device with a communication means for the contactless retrieval of control information stored in a data carrier (see col. 3, lines 57-65). Page also discloses that the smart card is a non-contact or contactless smart card (see fig. 2, col. 5, lines 57-60). Furthermore, Page discloses, that it is well known in the art that a smart card device contains at least a memory device for storing information and a transceiver to communicate with a smart card communication device. The smart card communication device communicates through the transceiver on the smart card to access the stored information. The smart card communication device may simply read the information, load the information into the memory device or modify existing data in the memory device. For example, if the owner of a smart card uses a smart card containing financial information to make a purchase, the smart card communication device can read the information including the owner's identity and the availability of funds however it may apply (see col. 1, line 34-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the references to arrive at the claimed invention. A motivation for doing so would have been to insure the appropriate regulation of transaction/communication.

7. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novis and Sakashita, further in view of Raith, U.S. Patent 6510515.

Regarding claim 6, the combination of Novis with Sakashita discloses a processing device as described above (see claim 4 rejection).

Although the combination discloses a processing device as described, the combination does not specifically disclose a processing device, in which the first communication means are adapted to operate in accordance with the GSM standard and/or UMTS standard.

However, applicant does not disclose how this adaptation would have been accomplished, and what stated problem this adaptation would have solved. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination for adaptation to operate in accordance with GSM and/or UMTS standard. Such adaptation would have been considered a mere design consideration, which fails to patentably distinguish over the prior art. Also, Raith discloses a mobile station (see fig. 4), which could operate in accordance with GSM standard apparatus, which may be utilized in a conventional GSM network (see col. 4, lines 4-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings to arrive at the claimed invention. A motivation for doing so would have been to provide a device wherein the standard uses would be a standard that embraces all areas of technology, resulting in global, seamless wireless services.

Regarding claim 7, the combination discloses a processing device as described above (see claim 1 rejection).

Although the combination discloses a processing device as described, the combination does not specifically disclose a processing device, in which the processing device is a reproducing device for the reproduction of an encrypted information signal, whose first communication means are adapted to receive the encrypted information signal and whose processing means are adapted to decrypt the received encrypted information signal, and in which the control information retrieved from the detachably connected data carrier by the second communication means includes key information for decrypting the received encrypted information signal.

However, Raith discloses a processing comprising of a receiver for receiving encrypted broadcast information and for receiving a current service key usable to decrypt said encrypted information; an encryption derivation device for deriving the encryption of the current service key according to information received wirelessly by the receiver (see fig. 5-7 and col. 21, lines 23-32). Raith also discloses a decryption key, which is provided on a SIM card and may be sent to a device for decryption in the device (see col. 13, lines 41-45).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teachings to arrive at the claimed invention because it would allow only eligible users to be able to receive services, and make it simple and fast to enable or disable service for a particular user.

Regarding claim 8, the combination discloses a processing device as described above (see claim 7 rejection).

Although the combination teaches a processing device as described, the combination does not specifically disclose a processing device in which the first communication means can be connected to a data network in order to retrieve the encrypted information signal.

However, Raith discloses a processing device (mobile station) comprising a receiver for receiving encrypted broadcast information associated with a broadcast information service on at least one broadcast resource (see col. 21, lines 25-27).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teachings as described to arrive at the claimed invention because it would allow only eligible users to be able to receive services, and make it simple and fast to enable or disable service for a particular user.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novis in view of Fries, U.S. Patent No. 6367701.

The combination discloses a processing device as described above (see claim 1 rejection).

Although, the combination discloses a processing device as described above, the combination does not specifically disclose a processing device, wherein the data carrier is detachably connected by magnetic means.

However, Fries discloses a data carrier (i.e., contact-less smart card) detachably connected by magnetic means (see col. 7, lines 20-24).

Therefore it would have been obvious to one of ordinary skill in the art to combine the teachings as described to arrive at the claimed invention. A motivation to do so would have been to facilitate to attaching and detaching procedure of the card.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novis and Sakashita, further in view of Benson, U.S. Patent No. 6292561.

Regarding claim 14, the combination discloses a processing device (see claim 1 rejection).

Although the combination discloses a processing device as described, the combination does not specifically disclose a processing device further including a second data carrier detachably connected to the housing of the processing device.

However, Benson discloses a processing device further including a second data carrier detachably connected to the housing of the processing device (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings to arrive at the claimed invention. A motivation to do so would have been to provide to the device the ability to switch between cards as desired.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novis and Sakashita, further in view of Yamada (US 6349824 B1).

The combination discloses a processing device as described above (see claim 1 rejection).

The combination, however, does not specifically disclose a processing device wherein the housing if the processing device is watertight.

Yamada discloses a processing device wherein the housing of the processing device is watertight (see col. 7, lines 43-51).



Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings described by Yamada with the teachings described by the combination to arrive at the claimed invention. A motivation for doing so would have been to protect the device against water.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PIERRE-LOUIS DESIR whose telephone number is (571)272-7799. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571)272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PIERRE-LOUIS DESIR/  
Examiner, Art Unit 2617